

# PATENT COOPERATION TREATY

From the  
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:  
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**DOCKETED**

Aug 19, 2004 5 Day Notice Written Opinion Due  
Aug 23, 2004 Due to Written Opinion

**PCT**

WRITTEN OPINION

(PCT Rule 66)

10 DEC 2004

Applicant's or agent's file reference  SNI-003PC		Date of Mailing (day/month/year) <b>22 JUN 2004</b>
International application No. PCT/US03/18202		REPLY DUE within 2 months/days from the above date of mailing
International filing date (day/month/year) 09 June 2003 (09.06.2003)	Priority date (day/month/year) 10 June 2002 (10.06.2002)	
International Patent Classification (IPC) or both national classification and IPC IPC(7): A61K 31/4172; C07D 207/27 and US Cl.: 514/424; 548/551		
Applicant APPLIED RESEARCH SYSTEMS ARS HOLDING N.V.		

1. This written opinion is the first (first, etc.) drawn by this International Preliminary Examining Authority.
2. This opinion contains indications relating to the following items:
  - I ☒ Basis of the opinion
  - II ☐ Priority
  - III ☒ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
  - IV ☐ Lack of unity of invention
  - V ☒ Reasoned statement under Rule 66.2 (a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
  - VI ☐ Certain documents cited
  - VII ☐ Certain defects in the international application
  - VIII ☐ Certain observations on the international application
3. The applicant is hereby invited to reply to this opinion.
 

**When?** See the time limit indicated above. ~~The applicant may, before the expiration of that time limit, request this Authority to grant an extension. See rule 66.2(d).~~

**How?** By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

**Also** For an additional opportunity to submit amendments, see Rule 66.4.  
For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4 bis.  
For an informal communication with the examiner, see Rule 66.6

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.
4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: 10 October 2004 (10.10.2004).

Name and mailing address of the IPEA/US Mail Stop PCT, Attn: IPEA/US Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450 Facsimile No. (703) 872-9306	Authorized officer <i>F. Roberts for</i> Laura L. Stockton, Ph.D. Telephone No. (571) 272-1600
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Form PCT/IPEA/408 (cover sheet)(July 1998)

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LAHIVE & COCKFIELD  
DOCKET DEPT.

**JUN 24 2004**

RETRIEVED: *Mac*  
FORWARDED: *U25 Jay*

**I. Basis of the opinion**

1. With regard to the elements of the international application:\*

- ☒ the international application as originally filed
- ☒ the description:  
 pages 1-119, as originally filed  
 pages NONE, filed with the demand  
 pages NONE, filed with the letter of \_\_\_\_\_
- ☒ the claims:  
 pages 120-133, as originally filed  
 pages NONE, as amended (together with any statement) under Article 19  
 pages NONE, filed with the demand  
 pages NONE, filed with the letter of \_\_\_\_\_
- ☒ the drawings:  
 pages 1-3, as originally filed  
 pages NONE, filed with the demand  
 pages NONE, filed with the letter of \_\_\_\_\_
- ☐ the sequence listing part of the description:  
 pages NONE, as originally filed  
 pages NONE, filed with the demand  
 pages NONE, filed with the letter of \_\_\_\_\_

2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.  
 These elements were available or furnished to this Authority in the following language \_\_\_\_\_ which is:

- ☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of the translation furnished for the purposes of international preliminary examination (under Rules 55.2 and/or 55.3).

3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the written opinion was drawn on the basis of the sequence listing:

- ☐ contained in the international application in printed form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. ☐ The amendments have resulted in the cancellation of:

- ☐ the description, pages NONE
- ☐ the claims, Nos. NONE
- ☐ the drawings, sheets/fig NONE

5. ☐ This opinion has been drawn as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

\* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed."

WRITTEN OPINION

International application No.

PCT/US03/18202

**III. Non-establishment of opinion with regard to novelty, inventive step and industrial applicability**

1. The question whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), or to be industrially applicable have not been examined in respect of:

- ☐ the entire international application,  
☒ claims Nos. 4, 9, 17-50 and 55-60

because:

- ☐ the said international application, or the said claim Nos. \_\_\_\_\_ relate to the following subject matter which does not require international preliminary examination (*specify*):

- ☒ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. 4,9,17-50 and 55-60 are so unclear that no meaningful opinion could be formed (*specify*):

These claims are dependent claims and are not drafted in accordance with the second and third sentences of Rule 6.4(a).

- ☐ the claims, or said claims Nos. \_\_\_\_\_ are so inadequately supported by the description that no meaningful opinion could be formed.  
☐ no international search report has been established for said claims Nos. \_\_\_\_\_.

2. A written opinion cannot be drawn due to the failure of the nucleotide and/or amino acid sequence listing to comply with the standard provided for in Annex C of the Administrative Instructions:

- ☐ the written form has not been furnished or does not comply with the standard.  
☐ the computer readable form has not been furnished or does not comply with the standard.

Form PCT/IPEA/408 (Box III) (July 1998)

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**V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement****1. STATEMENT**

Novelty (N)	Claims <u>1-3, 5-8, 10-16 and 51-54</u>	YES
	Claims <u>NONE</u>	NO
Inventive Step (IS)	Claims <u>51-54</u>	YES
	Claims <u>1-3, 5-8, 10-16</u>	NO
Industrial Applicability (IA)	Claims <u>1-3, 5-8, 10-16 and 51-54</u>	YES
	Claims <u>NONE</u>	NO

**2. CITATIONS AND EXPLANATIONS**

Claims 1-3, 5-8 and 10-16 lack an inventive step under PCT Article 33(3) as being obvious over Cameron et al. {U.S. Pat. 2002/0065308}.

Applicants claim 5-oxo-pyrrolidine compounds. Cameron et al. teach 5-oxo-pyrrolidine compounds which are structurally similar to the instant claimed compounds. See in Cameron et al., for example, Formula I wherein X is CH<sub>2</sub>, Z is phenyl, Q is carboxyl and R<sup>2</sup> is Ar (page 2, second column; and especially Example 2E on page 30). The difference between the compounds of the prior art and the compounds instantly claimed is that of homology (e.g., ethylene linkage attached to the 1-position of the pyrrolidine ring versus a propylene linkage in Cameron et al.). To those skilled in chemical art, one homologue is not such an advance over adjacent member of series as requires invention because chemists knowing properties of one member of series would in general know what to expect in adjacent members. The instant claimed compounds would have been obvious because one skilled in the art would have been motivated to prepare homologs of the compounds taught in the reference with the expectation of obtaining compounds which could be used in perfume compositions. Therefore, the instant claimed compounds would have been suggested to one skilled in the art.

Claims 51-54 meet the criteria set out in PCT Article 33(2)-(3), because the prior art does not teach or fairly suggest the invention find in these claims.

Claims 1-3, 5-8, 10-16 and 51-54 meet the criteria set out in PCT Article 33(4), and thus have industrial applicability because the subject matter claimed can be made or used in industry.

WRITTEN OPINION

International Examination No.  
PCT/US03/1

**Supplemental Box**

(To be used when the space in any of the preceding boxes is not sufficient)

**TIME LIMIT:**

The time limit set for response to a Written Opinion may not be extended. 37 CFR 1.484(d). Any response received after the expiration of the time limit set in the Written Opinion will not be considered in preparing the International Preliminary Examination Report.